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AUG 5, 97

Paper No. 11
EJS

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Creativity, Inc.

Serial No. 74/596,434

David M. Carter of Carter & Schnedler for Creativity, Inc.

Gerald C. Seegars, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney)

Before Simms, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Creativity, Inc. has appealed from the refusal of the
Trademark Examining Attorney to register IN PLAIN ENGLISH as
a trademark for "books concerning computers and
technology."¹ Registration has been refused pursuant to
Sections 2(d) and 2(e)(1) of the Trademark Act, 15 U.S.C.
1052(d) and 1052(e)(1).

The case has been fully briefed; an oral hearing was
not requested.

Turning first to the refusal pursuant to Section 2(d), it is the Examining Attorney's position that applicant's mark, as used on its identified goods, so resembles the mark PLAIN ENGLISH, registered on the Supplemental Register for "computer programs,"² as to be likely to cause confusion or mistake or to deceive.

Our determination of this issue is based on an analysis of all of the relevant factors, as set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Considering the marks first, we find that they are virtually identical. Although applicant's mark has the initial word IN, the addition of this word does nothing to change the commercial impression of the mark. Both look and sound very much alike, and both have the same connotation of "simple, clearly understood language." For this reason, this case differs from those cited by applicant in which no likelihood of confusion was found between marks with different first words, but the same second words.

With respect to the goods, we recognize that applicant's goods are books concerning computers and technology, and the cited registration is for computer programs. However, it is not necessary that the goods of the parties be similar or competitive, or even that they

¹ Application Serial No. 74/596,434, filed November 8, 1994, and asserting first use and first use in commerce on May 23, 1993.

move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

In this case, the goods in the cited registration are identified broadly as "computer programs," without any limitation as to their subject matter. It is not clear what the subject matter of the computer programs is, but in view of the nature of the mark the computer programs could well include the subject of computers and technology. Computer programs about computers and technology, and books about computers and technology are likely to appeal to the same class of consumers, and to be purchased by the same people. Further, such goods are likely to be sold in the same channels of trade, for example, a store specializing in computer-oriented products is likely to sell both computer programs about computers and books about computers. Consumers, encountering these goods at the same store and

² Registration No. 1,373,141, issued November 26, 1985; Section

sold under the virtually identical marks at issue here, would be likely to believe that the goods emanate from the same source.

Further, and contrary to applicant's assertion, the purchasers of applicant's and the registrant's goods are not likely to be highly sophisticated. Because of the widespread use of computers in virtually all facets of American life, computer-oriented materials are no longer purchased and used only by computer experts. Moreover, the nature of the marks involved herein, PLAIN ENGLISH and IN PLAIN ENGLISH, indicate that the books and computer programs would not be directed to computer professionals, but would be helpful to those less sophisticated about computers. This is borne out by applicant's specimens, which state that DOS is "the foundation for every single program that runs on your computer. So why should it be a mystery to you?" We would also point out that even sophisticated consumers would be unlikely to note the minor difference between applicant's mark, IN PLAIN ENGLISH, and the registered mark, PLAIN ENGLISH, or, even if they did note this difference, they would be unlikely to assume that this slight difference indicated that the products sold under the marks emanated from different sources.

Applicant has pointed to the fact that the cited mark is registered on the Supplemental Register, and that it

coexists on that register with the mark (IN PLAIN ENGLISH) for educational legal books,³ presumably to show that PLAIN ENGLISH is a weak mark which is not entitled to a broad scope of protection. In this instance, the fact that the cited registration is registered on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. **In re Texas Instruments Incorporated**, 193 USPQ 678 (TTAB 1976).

However, even a weak mark is entitled to protection, and in the present case, the marks are so similar and the goods are so related that we find confusion would be likely to occur if they were used contemporaneously.

Accordingly, the refusal of registration pursuant to Section 2(d) is affirmed.

This brings us to the refusal of registration pursuant to Section 2(e)(1), on the ground that applicant's mark is merely descriptive of books concerning computers and technology. The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. **In re Venture Lending Associates**, 226 USPQ 285, 286 (TTAB 1985). Moreover, the question of whether a

³ Registration No. 1,402,649, issued July 22, 1986; Section 8

particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters goods bearing the mark in the marketplace. **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986).

We find that applicant's mark, IN PLAIN ENGLISH, immediately and directly conveys to purchasers and potential purchasers information about a significant characteristic of applicant's goods, namely, that they are written in easy-to-understand language. The NEXIS articles submitted by the Examining Attorney show that the phrase "in plain English" is readily understood to have such a meaning.⁴ Applicant, too, shows its recognition that this is the meaning that would be ascribed to the phrase by using, in its specimens, sentences such as "It takes very special writers to turn computer gobbledygook (sic) into plain English." Moreover, applicant touts the fact that its books are written in understandable language. The cover page of its specimen contains the highlighted phrase "Computer Books in Language

affidavit accepted.

⁴ See, for example, "...the 41-page guide provides no-nonsense information in plain English," ("The Times," April 1, 1995); "This short volume is one of those rarities--a book for prospective buyers and new users that delivers useful, basic

You Can Understand and Use," while the second page of the specimen includes the following statements:

This book, with a minimal amount of "computerese" helps you tame DOS. Here, in plain English, we make learning DOS a pleasure!

Computers are a lot easier than you think, IF they are explained in language you can understand and use. The IN PLAIN ENGLISH series does just that, presenting you with books written by the best COMMUNICATORS in the computer field, writers who know their subject and relate it to you in everyday, comprehensible, PLAIN English.

Applicant argues that a substantial degree of imagination, thought and perception is required for a consumer to determine what the goods are once he or she sees the mark, and points out that the mark does not contain the words books, computers or technology. However, the test for determining if a mark is merely descriptive is not whether one can guess the goods from viewing the mark. As stated above, whether a phrase is merely descriptive must be determined not in the abstract but in relation to the goods for which registration is sought. When the mark IN PLAIN ENGLISH is viewed in connection with books concerning computers and technology, it conveys that the books are written in clear and understandable language.

Accordingly, the refusal of registration is affirmed on this ground, too.

information in plain English...." ("The Commercial Appeal,"

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Decision: The refusals made pursuant to Sections 2(d) and 2(e)(1) are affirmed.

R. L. Simms

E. J. Seeherman

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board